

Appl. No. 10/666,543
Amdt dated: February 28, 2005
Reply to Office Action of September 28, 2004

REMARKS/ARGUMENTS

Claims 1-27 are pending in this Application. The Office Action mailed on September 28, 2004, includes the following rejections:

1. Claims 1-6 and 9-13 are rejected under 35 U.S.C. 112 first paragraph.
2. Claims 2-8, 13, 19 and 27 are rejected under 35 U.S.C. 112 second paragraph.
3. Claims 1-6 are rejected under 35 U.S.C. 102 as being anticipated by WO 95/15997.

Applicants respectfully address the basis for each of the Examiner's rejections below.

Claim Rejections – Claims 1-6, and 9-13 are rejected under 35 U.S.C. § 112 first paragraph

Claims 1-6, and 9-13 have been rejected under 35 U.S.C. § 112. The claims as amended overcome the rejection. The Action states the definition of the compound is too broad. Claim 1 has been amended to further define the organic compounds used in the synthetic method, as such, they serve to define the organic compounds. The present invention clearly discloses detailed synthesis of a variety of organic molecules that include nitroalcohol compounds and nitro containing aromatic compounds. Thus, amended claim 1 overcomes the rejection.

Claims 2-6 and 9-13 depend from amended claim 1 which is now allowable, and thus also allowable. Therefore, withdrawal of the rejection and allowance of the claims is respectfully requested.

Claim Rejections – Claims 2-8, 13, 19 and 27 are rejected under 35 U.S.C. § 112 second paragraph

Claims 2-8, 13, 19 and 27 are rejected under 35 U.S.C. 112 second paragraph. Claims 2-6, 8, 13, 19 and 27 have been amended to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The amendment defines the number of subunits that may be included in n as an integer, thereby eliminating any confusion. Therefore, withdrawal of the rejection and allowance of the claims is respectfully requested.

Applicants disagree with the Action's statement that claim 6 is indefinite. Claim 6 as written in original form clearly defines that n is 40. Therefore, withdrawal of the rejection and

Appl. No. 10/666,543
Amdt dated: February 28, 2005
Reply to Office Action of September 28, 2004

allowance of the claim is respectfully requested.

Additionally, Applicants disagree with the assertion that claim 7 is indefinite. Claim 7 as originally written contains no n therefore does not lead to numeric uncertainty. Claim 7 clearly defines that R₂ is --H or a C₁-C₄ alkyl group. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

Claim Rejections – Claims 1-6 are rejected under 35 U.S.C. § 102(b).

The Action rejects 1-6 under 35 U.S.C. 102(b) as anticipated by WO95/15997, which is said to disclose the claimed invention specifically, “the process of making an organic compound by reacting sulfonic acid ester with a polyether in an inorganic metal ion.”

To anticipate a claim, a reference must teach every element of the claim either impliedly or explicitly. See MPEP §2131. As elaborated in *Richardson v. Suzuki Motor Co.*, “[t]he identical invention must be shown in as complete detail as is contained in the claim.” 9 U.S.P.Q.2d 1913, 1920(Fed. Cir. 1987). Further, to anticipate a claim, “a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996). As stated by the Courts in *Akzo N.V. v. ITC*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986) and *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773, 778 (Fed. Cir. 1985), the anticipating prior art reference “must enable one skilled in the art to practice the claimed invention, thus placing the allegedly disclosed matter in the possession of the public.”

Applicants respectfully submitted that the cited reference fails to meet the standard of teaching all elements of the claimed invention either explicitly or impliedly, and thus does not anticipate any of the rejected claims. Applicants respectfully submit that WO95/15997, does not anticipate Applicant's claims 1-6 because WO95/15997 does not identically disclose Applicant's invention. The cited reference relates to the reaction of a sulfonic acid ester with a polyether, it does not relate to a method of producing an organic compound in a solvent minimized environment. Furthermore, the cited reference does not disclose a catalytic amount of an oxyethylene ether for a time sufficient for the oxyethylene ether to at least partially complex the

Appl. No. 10/666,543
Amtdt dated: February 28, 2005
Reply to Office Action of September 28, 2004

metal of the at least one inorganic or organic metal reagent. Additionally, the cited reference does not contain each and every element of the amended claim. For example, the cited reference does not contain at least one organic reactant include one or more aminogroups into contact with at least one inorganic metal reagent and in the presence of a catalytic amount of an oxyethylene ether.

Additionally, claims 2-6 depend from amended claim 1 which is now allowable, and thus claims 2-6 are thus also allowable.

Applicants respectfully submit that claims 1-6, are not anticipated by the cited reference. The invention cited in the reference and the instant invention are different; therefore the reference does not identically disclose Applicant's claimed invention. Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. §102(b).

Claims 14-18 and 20-26

The Action states that "claims 14-18 and 20-26 are objected to as being dependent upon a rejected base claim, but would be allowable if written in independent form."

Applicants assert that independent claims 14 and 20 are not objected too nor are they rejected and are thus, prima facie, allowable. Claims 15-18 depend from allowable claim 14, and thus Claims 15-18 are also allowable. Claims 21-26 depend from allowable claim 20, and thus Claims 21-26 are also allowable. Applicants therefore respectfully request allowance of the pending claims 14-18 and 20-26.

Appl. No. 10/666,543
Amdt dated: February 28, 2005
Reply to Office Action of September 28, 2004

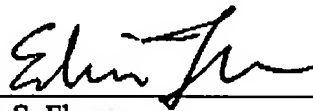
Conclusion

In light of the remarks and arguments presented above, Applicants respectfully submit that the claims in the Application are in condition for allowance. Favorable consideration and allowance of the pending claims 1-27 are therefore respectfully requested.

If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below:

Dated: February 28, 2005.

Respectfully submitted,



Edwin S. Flores
Reg. No. 38,453

ATTORNEY FOR APPLICANT

Chalker Flores, LLP
12700 Park Central, Ste. 455
Dallas, TX 75251
214.866.0001 Telephone
214.866.0010 Facsimile

ESF/cps